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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,957	12/09/2003	Richard C. Ferri	AUS920030843US1	3686
45371 7590 08/19/2008 IBM CORPORATION (AUS) c/o Rudolf O Siegesmund Yce & Associates, P.C. P.O. Box 802333 DALLAS, TX 75380				
EXAMINER				
MUHEBBULLAH, SAJEDA				
ART UNIT		PAPER NUMBER		
2174				
MAIL DATE		DELIVERY MODE		
08/19/2008		PAPER		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/730,957
Filing Date: December 09, 2003
Appellant(s): FERRI ET AL.

Rudolph O. Siegesmund, Attorney
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 29, 2008 appealing from the Office action mailed November 28, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,043,817	Bolnick et al.	03-2000
6,545,687	Scott et al.	04-2003
6,717,596	Nason et al.	04-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. Claims 1-4, 10-13, 16-17, 21-28, 34-37, 40-41 and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolnick et al. ("Bolnick", US 6,043,817).

As per claim 1, Bolnick teaches a method for automatically organizing a plurality of icons on a computer desktop (col.7, lines 28-33; col.12, lines 25-55) comprising:

using a computer, performing the following series of steps:

displaying a graphical user interface having a define segments menu and a submit control (col.17, lines 3-19; *selection of a menu item is equivalent to submission control*);

responsive to a user selecting a segment location, a segment size, an icon group, a icon organization at the define segments menu (col.18, lines 30-51), and activating the submit control

(col.19, lines 7-11; *selection and storing of modified menu items is equivalent to submission control*),

creating a segment on the desktop (col.17, lines 12-19);
defining the segment size in relation to the desktop (col.19, lines 26-56);
classifying the plurality of icons into the icon group (col.16, lines 11-55);
placing the icon group into the segment (col.16, lines 11-55, col.21, lines 38-49); and
organizing the icons within the segment in accordance with the icon organization (col.9, lines 44-48; col.21, lines 38-49; *ordering and arranging icons is a method of organization*);
wherein the only user actions required to automatically organize the plurality of icons on the computer desktop are for a user to make a plurality of user selections at the define segments menu and to activate the submit control (col.21, lines 38-49; *activation of the cleanup operation is thru submission of a menu selection on the GUI*).

As per claim 2, Bolnick teaches the method further comprising:

analyzing the icons to determine the icons' attributes and using the icons' attributes to classify the icons (col.16, lines 11-55).

As per claim 3, Bolnick teaches the method wherein the icons' attributes are a type of application associated with each of the icons (col.16, lines 28-38).

As per claim 4, Bolnick teaches the method wherein the organization of the icons is to shrink the icons down to the icons' smallest possible size (col.31, lines 28-40).

As per claim 10, Bolnick teaches the method wherein the segment is user defined (col.19, lines 26-56).

As per claim 11, Bolnick teaches the method wherein the icon group is a group of webpages (col.8, lines 27-30).

As per claim 12, Bolnick teaches the method wherein the icon group is a group of games (col.8, lines 27-30).

As per claim 13, Bolnick teaches the method wherein the icon group is a group of development tools (col.8, lines 27-30).

Claims 16-17 and 40-41 are individually similar in scope to claims 3-4 respectively, and are therefore rejected under similar rationale.

Claims 25-28 are similar in scope to claims 1-4 respectively, and are therefore rejected under similar rationale.

Claims 21-24, 34-37, and 45-48 are individually similar in scope to claims 10-13 respectively, and are therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

2. Claims 5-7, 18-20, 29-31, and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolnick et al. ("Bolnick", US 6,043,817) in view of Scott et al. ("Scott", US 6,545,687).

As per claim 5, Bolnick teaches the method wherein the organization of the icons is to change the size of the icons (Bolnick, col.31, lines 28-40). However, Bolnick does not teach the method such that the icons fill the segment. Scott teaches a method of organizing a plurality of icons such that the size of the icons are changed to fill the segment (Scott, col.16, lines 17-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include Scott's teaching with Bolnick's method in order to make use of all available space.

As per claim 6, Bolnick teaches the method wherein the organization of the icons is to view the icons in normal view (Bolnick, col.31, lines 28-29). However, Bolnick does not teach the method wherein if the icons do not fit into the segment at normal size, then to shrink the size of the icons until the icons fit into the segment. Scott teaches a method of organizing a plurality of icons such that the size of the icons are shrunk to fit the icons into the segment (Scott, col.16, lines 17-23). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Scott's teaching with Bolnick's method in order to be able to view all of the icons at once.

As per claim 7, Bolnick teaches the method wherein the organization of the icons is to view the icons in normal view (Bolnick, col.31, lines 28-29). However, Bolnick does not teach the method wherein if the icons do not fit into the segment at normal size, then to add a scroll bar within the segment. Scott teaches a method of organizing a plurality of icons such that a scroll bar is added when the icons do not fit within the segment (Scott, col.1, lines 55-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Scott's teaching with Bolnick's method in order to be able to view all of the icons at normal size.

Claims 18-20, 29-31, and 42-44 are individually similar in scope to claims 5-7 respectively, and are therefore rejected under similar rationale.

3. Claims 8-9, 14-15, 32-33, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolnick et al. ("Bolnick", US 6,043,817) in view of Nason et al. ("Nason", US 6,717,596).

As per claim 8, Bolnick teaches the method of claim 1 wherein the segment is defined by steps comprising:

- defining a segment location (Bolnick, col.10, lines 40-43);
- defining a segment size (Bolnick, col.10, lines 40-43);
- defining the icon group associated with the segment (Bolnick, col.6, lines 45-47; col.8, lines 26-67); and
- defining the icons organization within the segment (Bolnick, col.6, lines 45-47; col.9, lines 44-48).

However, Bolnick does not teach the step of defining whether the segment covers the wallpaper on the desktop. Nason teaches a method of organizing segments on a desktop wherein segments are defined to be located outside the border of the desktop (Nason, col.6, lines 19-21; col.26, lines 23-33; Fig.33, *display area 3301 contains a default wallpaper*). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Nason's teaching with Bolnick's method in order to be able to view numerous segments at once.

As per claim 9, Bolnick teaches defining segments within a desktop (Bolnick, col.10, lines 40-43). However, Bolnick does not teach the method of claim 1 wherein the segment does not cover the wallpaper on the desktop. Nason teaches a method of organizing segments on a desktop wherein segments do not cover the desktop (Nason, col.6, lines 19-21; col.26, lines 23-33; Fig.33, *display area 3301 contains a default wallpaper which is not covered by segments*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include Nason's teaching with Bolnick's method in order to be able to view numerous segments at once.

Claims 14 and 38 are similar in scope to the combination of claims 2 and 9, and are therefore rejected under similar rationale.

Claims 15, 32, 39 are individually similar in scope to claim 8, and are therefore rejected under similar rationale.

Claim 33 is similar in scope to claim 9, and is therefore rejected under similar rationale.

(10) Response to Argument

Applicant argues the following:

a) Bolnick does not discuss organizing icons within a desktop segment by resizing the icons within the segment.

b) Bolnick's method is complicated and requires many steps whereas applicant's invention provides for organizing icons on a desktop by only making selections from a menu and activating a submit control therefore requiring fewer user actions.

c) Bolnick does not discuss resizing icons to smallest size possible.

d) A browser window, as taught by Scott, does not provide the same functionality of a desktop, and therefore increasing the size of icons in a browser window does not have the same advantages as increasing the size of icons in a desktop segment.

e) Scott only discusses increasing and decreasing icon size to fill a window, and does not at all discuss having the icons default to normal size and then shrinking them if necessary.

f) Scott does not teach adding scroll bars to a desktop segment.

g) Neither of the cited portions of Nason discusses anything about wallpaper on a desktop, much less defining segments of the desktop according to whether the segments cover wallpaper on the desktop. Nason is concerned with the area outside of the desktop, whereas claim 8 is concerned with the area within the desktop and whether segments in that area cover wallpaper on the desktop.

The Examiner disagrees for the following reasons:

Per a), In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *resizing the icons*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Per b), Bolnick teaches the invention as claimed wherein the only user actions required to automatically organize the plurality of icons on the computer desktop are for a user to make a plurality of user selections at the define segments menu and to activate the submit control (col.21, lines 38-49, *selection of a menu item is equivalent to submission control*). Applicant's invention claims making a plurality of selections as taught by Bolnick.

Per c), Bolnick teaches the icons to be displayed in a small view and to be able to resize the icons and maintain the smallest size possible (Bolnick, col.31, lines 28-50).

Per d), In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based

on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Scott is combined to teach the method of changing the size of icons to fill a segment whereas Bolnick teaches the limitation of a desktop segment.

Per e), In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Scott is combined to teach the method of changing the size of icons to fill a segment whereas the limitation of viewing icons in normal size is taught by Bolnick.

Per f), In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Scott is combined to teach the method of adding scroll bars whereas the limitation of a desktop segment is taught by Bolnick.

Per g), In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Nason teaches the display of a desktop containing a default wallpaper (Fig.33, 3301). Anything displayed within the computer screen is considered an onscreen work area a.k.a. desktop therefore Nason is concerned with the area within the desktop and displays segments that do not cover the wallpaper (Fig.33).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 2174

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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